

REMARKS**Status of the Claims**

Claims 3, 5, 16, 18, 20, 22, 24, 26 and 27 are pending in this application. All claims are rejected. Claims 1-2, 4, 6-15, 17, 19, 21, 23, 25, and 28-40 remain cancelled without prejudice. Applicants reserve the right to pursue cancelled claims in a continuing application. Claim 5 has been amended. Applicants respectfully request reconsideration of the rejections in view of the remarks set forth below.

Response to Rejections Under 35 U.S.C. § 103

The Examiner has maintained the rejection of claims 3, 5, 16, 18, 20, 22, 24, 26 and 27 under 35 U.S.C. § 103(a) for allegedly being obvious over U.S. Patent No. 6,333,298 (“Waddoups et al.”) in combination with either U.S. Patent No. 4,604,491 (“Dressler et al.”) or U.S. Patent No. 5,254,274 (“Ho et al.”), and in further view of U.S. Patent No. 5,602,086 (“Le et al.”). The Examiner was not persuaded by the arguments set forth in the October 16, 2007 Amendment and Response, and has specifically rebutted applicants’ contentions regarding a lack of motivation to modify Waddoups et al. (see page 4 of the Office Action). Applicants respectfully disagree with the Examiner on this issue. However, in an effort to streamline prosecution and advance this application to allowance, applicants instead choose to focus this response solely on the construction of the transitional language “consisting essentially of” as recited in claim 3.

Applicants submitted the Declaration of Dr. Edward T. Hessell Under 37 C.F.R. § 1.132 (“the Hessell Declaration”) with the October 16, 2007 Response in support of a construction of “consisting essentially of” in claim 3 that excludes calcium detergents from the scope of the claims. Specifically, the Hessell Declaration demonstrated for the record that the

addition of a calcium detergent, namely 400 TBN overbased calcium sulfonate, to various compositions of the invention as recited in claim 3 adversely affects the water separation properties of same. Applicants pointed out that Waddoups et al. strictly requires the inclusion of calcium detergents, preferably overbased calcium sulfonates, in lubricating compositions. Applicants therefore concluded that claim 3, which specifically excludes calcium detergents by virtue of the “consisting essentially of” language, does not read on the calcium detergent-containing lubricating compositions of Waddoups et al. Applicants argued, therefore, that no obviousness rejection based on Waddoups et al. can be made because Waddoups et al. requires the presence of a calcium detergent, and claim 3 specifically excludes calcium detergents from the composition.

Applicants note that the Examiner has not rebutted the fact that Waddoups et al. requires the presence of a calcium detergent. Furthermore, it appears that the Examiner has misunderstood the purpose of the Hessel Declaration; the Examiner contends that the Hessel Declaration “failed to rebut the established *prima facie* case of obviousness for several reasons” (page 5 of the Office Action). Contrary to the Examiner’s contention, and as set forth in the October 16, 2007 Response (summarized above), the Hessel Declaration establishes for the record that a calcium detergent adversely affects the water separation properties of lubricating compositions according to the invention. Thus, the Hessel Declaration supports that exclusion of calcium detergents from the scope of the invention by virtue of the “consisting essentially of” language. Applicants did not argue that the Hessel Declaration sets forth any objective evidence of non-obviousness to rebut the alleged *prima facie* case of obviousness.

Regarding the construction of claim 3, the Examiner correctly notes that the transitional phrase “consisting essentially of” limits the scope of a claim to the specified

materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention (page 5 of the Office Action, citing *In re Herz*). Again, the Examiner does not rebut the fact that a calcium detergent adversely affects the water separation properties of claimed compositions, but instead implicitly contends that water separation is not a basic and novel characteristic of the claimed invention. In support, the Examiner cites MPEP § 2111.03 stating that “for the purposes of searching for and applying prior art..., absent a clear indication in the specification or the claims of what the basic and novel characteristics are, ‘consisting essentially of’ will be construed as equivalent to ‘comprising.’” The Examiner also cites a portion of the instant specification, presumably to show what the Examiner believes the basic and novel characteristics of the claimed invention are. The Examiner appears to be implicitly suggesting that it is necessary for the specification or the claims to explicitly set forth all of the basic and novel characteristics of the invention. Applicants strongly disagree. There is no requirement set forth in either the MPEP or case law that supports the contention that the specification or claims must explicitly set forth all of the basic and novel characteristics of the claimed invention. MPEP §2111.03 sets forth only an examination procedure to be followed in the eventuality that the specification or the claims do not clearly indicate what the basic and novel characteristics are.

Applicants assert that water separation is a basic and novel characteristic of the claimed invention, and that this is well-known to and readily understood by one of ordinary skill in the art reading the instant application. In support, applicants cite a patent from the art to which the instant application pertains (*i.e.*, lubricating compositions for industrial applications) and further submit herewith the Hunter Declaration, which unequivocally establishes for the

record that one of ordinary skill in the art would understand that water separation is a basic and novel characteristic of the invention.

Applicants direct the Examiner's attention to U.S. Patent No. 5,334,329 ("Vinci et al."), which issued on August 2, 1994 and is representative of general knowledge in the relevant art at the time of filing of the above-referenced application. Vinci et al., in the "Background of the Invention" section, teaches the following regarding the importance of water separation (*i.e.*, demulsibility) for lubricating compositions (col. 2, lines 1-30):

It is well known that water is an undesirable contaminant in lubricants and functional fluids. Water not only reduces the effectiveness of the lubricant or fluid, it tends to form deleterious by-products, particularly in relation to the metal parts in contact with or utilizing the lubricant or functional fluid. For example, water present in a lubricant is responsible for the formation of objectionable mayonnaise-like sludge which in turn promotes the formation of hard-to-remove deposits from various parts of the machinery being lubricated. Presumably, the formation of the sludge is preceded by the water forming an emulsion with the lubricant oil. While water should be separable from an oil or functional fluid due to immiscibility, some of the additives in the lubricants or functional fluids may have water-solubility sufficient to form emulsions which are difficult to remove. Also, the presence of additives such as ashless dispersants and detergents facilitate the formation and increase the stability of emulsions thereby making it difficult to separate the water from the oil or functional fluid. Therefore, it is important to minimize the presence of water in lubricating compositions and functional fluids to reduce or eliminate the formation of such emulsions.

Obviously, lubricants having minimum contact with water will not present serious problems of water-oil emulsions. However, it is difficult to eliminate contact with water, particularly during storage, handling, and/or use (e.g., in a steel mill environment).

The above excerpt clearly demonstrates that the art recognized that water-contamination is difficult to avoid in lubricating compositions for industrial applications, particularly during use, and that the formation of oil and water emulsions in this context is detrimental to the

effectiveness of the lubricating compositions. Vinci et al. thus shows, by way of example, that one of ordinary skill in the art would recognize the important of lubricating compositions possessing good water separation (i.e., demulsibility).

This fact is also supported by the Hunter Declaration, in which Dr. Hunter declared the following (paragraph 4):

Based on all my experience and knowledge, it is desirable that, for the [instant] application, lubricating compositions have water separation (demulsibility) in order to reduce or avoid various problems such as loss of lubricity, corrosion, additive degradation, and filter plugging.

For the foregoing reasons, applicants respectfully proffer that water separation is a basic and novel characteristic of the claimed invention.

In view of the above remarks and the Hunter Declaration, applicants submit that any additive which materially affects the water separation (demulsibility) of a composition as claimed in claim 3 is specifically excluded from the scope of the claim by virtue of the “consisting essentially of” claim language. Furthermore, in view of the Hessel Declaration, which clearly demonstrates that a calcium detergent (as required by Waddoups et al.) materially (and adversely) affects the water separation of a composition according to the invention, applicants assert that calcium detergents are specifically excluded from they scope of claim 3. Accordingly, Waddoups et al., either alone or in combination with the other cited references, does not teach each and every element of the claim, because Waddoups et al. specifically requires the presence of a calcium detergent (a fact which the Examiner has not rebut). Accordingly, applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) over Waddoups et al. in view of any or all of the cited references.

As an additional matter, the Examiner has contended that the Hessell Declaration is insufficient to rebut the alleged *prima facie* case of obviousness. As mentioned above, the Hessell Declaration was not provided to set forth objective evidence of non-obviousness. Nevertheless, applicants address the Examiner's contentions to the extent that they pertain to the sufficiency of the declaration to establish that calcium detergents materially affect the water separation property of compositions of the invention.

Regarding the Hessell Declaration, the Examiner specifically contends that (pages 5-6 of the Office Action, emphasis original):

The results presented pertain to one calcium detergent, an overbased calcium sulfonate, and the calcium detergent of Waddoups [et al.] may be neutral or overbased, and may comprise calcium phenates, salicylates, sulfonates or mixtures thereof. [citation]. It is not clear that the other calcium detergents taught as suitable in Waddoups [et al.] also have the same results in the property of water separation in a composition containing a Group III mineral base oil and an alkylated naphthalene.

Applicants submit herewith the Hunter Declaration, which establishes for the record that other calcium detergents taught as suitable in Waddoups et al. do have the same results in the property of water separation in a composition containing a Group III mineral base oil and an alkylated naphthalene. Specifically, Dr. Hunter declared (paragraph 6):

Based on my technical training and experience with lubricant compositions and their physical properties, and based on the results set forth in the Hessell Declaration, in my opinion other calcium detergents, such as calcium phenates, salicylates, sulfonates, and mixtures thereof (as described in the Waddoups patent) would also significantly and adversely affect the water separation if added to compositions of the above-referenced application. Furthermore, the water separation would be significantly and adversely affected by addition of the above-mentioned calcium detergents to compositions of the above-referenced application, either in their overbased form or their neutral form.

The evidentiary record is clear, and fully supports the conclusion that calcium detergents in general, as disclosed and required by Waddoups et al., are specifically excluded from the scope of claim 3. Accordingly, applicants respectfully request that any rejection of claim 3 under 35 U.S.C. §103(a) based on Waddoups et al. be reconsidered and withdrawn.

For all of the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the pending rejection of claim 3 under 35 U.S.C. §103(a) over Waddoups et al. in combination with either Dressler et al. or Ho et al., and in further view of Le et al.

Applicants have not independently addressed the rejection of the dependent claims. Applicants submit that for at least similar reasons as to why independent claim 3 is allowable, as set forth above, claims 5, 16, 18, 20, 22, 24, 26 and 27 (which each depend therefrom) are likewise allowable. Applicants reserve the right to independently address the rejections of the dependent claims should such be necessary and/or appropriate.

CONCLUSION

Based on the foregoing amendments and remarks, applicants respectfully request reconsideration and withdrawal of the pending rejections and allowance of this application. Applicants respectfully submit that the instant application is in condition for allowance.

In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided. Favorable action by the Examiner is earnestly solicited.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 0444-4083US1.

Applicants believe this paper to be timely filed within the two-month period after the filing of a Notice of Appeal. In the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 0444-4083US1.

Respectfully submitted,
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